

REMARKS

Claims 1–26 are pending in the application. The 3 July 2002 Office Action objected to claims 2–7, 10, 12–17, and 21–24, and rejected claims 1–26 are rejected under 35 USC § 103. The rejection of the claims is traversed for the reasons given below.

Summary of Interview

Applicants' attorneys, Matthew J. Marquardt and Frank J. DeRosa, thank Examiner Kyle for participating in the telephone interview on 29 July 2002. In that interview, Applicants' attorneys and the Examiner discussed the references applied in the rejection of claims 1-26 in the 3 July 2002 Office Action, and agreed that the those references do not disclose or suggest the invention claimed in claims 1-26, for at least the reasons discussed below.

However, the Examiner stated that he would conduct further searching to attempt to uncover any references likely to be considered relevant in a future office action, and then forward the references to Applicants' attorneys for consideration in connection with a written response to the 3 July 2002 Office Action. This procedure would avoid the need to issue another office action to cite any new prior art uncovered in such searching. On 20 September 2002, the Examiner faxed to Applicants' attorney, Matthew Marquardt, summaries of five new references. The Examiner's cooperation in advancing prosecution of this application in this way is appreciated.

Before addressing the new references, the objection to and the rejection of the claims in the 3 July 2002 Office Action are addressed.

The Objection to the Claims 2-7, 10, 12-17 and 21-24

At page 2 of the Detailed Action, the Examiner objected to claims 2-7, 10, 12-17, and 21-24 because he believed that use of the word "criteria" was inconsistent (in grammatical number) in the phrase "at least one filter criteria", and suggested use of the singular form "criterion" instead. The Examiner's suggestion has been adopted in the amended claims without admission that the objection was proper.

The amendment to claims 2-7, 10, 12-17, and 21-24 referred to above addresses a grammatical issue only, and does not affect the scope or patentability of the claims.

Claims 25 and 26 were amended to change "include" to "including" to agree with the verb "uses" in the concerned clause of the respective claim. These changes also do not affect the scope or patentability of claims 25 and 26.

The Rejection of Claims 1-26 Under 35 U.S.C. § 103

Claims 1-26 were rejected under 35 U.S.C. § 103 as unpatentable over Potter et al. US patent 5,787,402, in view of Woerner et al. ("e-Bay for Dummies"). As indicated above, Applicants traverse.

Claim 1

Claim 1 claims a system for conducting electronic trading of foreign exchange forwards comprising a central server, a plurality of trading workstations and at least one remote server interfacing the trading work stations to the central server, wherein the at least one remote server mediates currency trades between traders by consulting pre-set trading configurations associated with each trader. Claim 1 also includes the following limitation:

wherein the pre-set trading configurations include temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state.

Below we refer to this limitation as the "penalty box limitation."

Despite citing to numerous passages in Potter et al.,¹ the Examiner recognized the disclosure deficiencies in Potter et al. as they relate to the invention claimed in claim 1; and stated:

Potter et al do not specifically disclose pre-set trading configurations including temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state.

Thus, the Examiner admitted that Potter et al. does not disclose the penalty box limitation of claim 1, and cited Woerner et al. as disclosing that limitation.

¹ Applicants do not agree with or acquiesce in the Examiner's position that these passages disclose the subject matter of claim 1.

Woerner et al. discusses the E-Bay auction system for consumer goods (which we previously referred to, perhaps incorrectly, as commodities), but does not, among other things, disclose or suggest the penalty box limitation claimed in claim 1. The disclosure in Woerner et al. on which the Examiner relied is as follows (page 135, lines 4-10):

eBay has a message for non-paying bidders: The policy is *four strikes and you're out*. (Emphasis in original.) After the first two complaints about a non-paying (deadbeat) bidder, eBay gives the bad guy or gal a warning. After a third offense, the non-paying bidder (deadbeat! deadbeat!) bidder gets a 30 day suspension. If there is a fourth offense, the (ahem) non-paying bidder is suspended from eBay for good and becomes a NARU (Not A Registered User). Nobody's tarred and feathered, but you probably won't see hide nor hair of him or her again on eBay.

Clearly, this quoted passage does not disclose or suggest the penalty box limitation claimed in claim 1, e.g., because it does not involve "pre-set trading configurations include[ing] temporary restrictions on a specified trader set by a first trader." Restating the Interview Summary above, the Examiner has agreed with this. Further, recognizing that the claims are allowable over the Woerner et al. and Potter et al. references, the Examiner agreed to conduct further searching and to provide Applicants' attorneys with any relevant references turned up in the search. As mentioned above, Applicants' attorneys and the Examiner agreed that this procedure would advance prosecution without the need for an office action based on any new prior art uncovered by the Examiner in this search.

Independent Claims 10, 11, 21 & 24-26, and Dependent Claims

Independent claims 10, 21 and 24-26 are system claims that include language the same as or similar to that quoted above for the penalty box limitation claimed in claim 1. Claim 11 is a method claim that includes the following limitation:

receiving pre-set trading configurations from a first trader associated with a specified trader to place the specified trader into a penalty box state relative to the first trader.

As such, Woerner et al. and Potter et al. also do not disclose or suggest the inventions claimed in claims 10, 11, 21 and 24-26, and the inventions claimed in the claims dependent upon those claims and on claim 1.

New References Identified by the Examiner

The Examiner identified five new references in 20 September 2002 fax, stating that the new references "related to a trader blocking feature."

Applicants' attorneys have reviewed these references and have found them not to be relevant to the penalty box limitation claimed in claim 1 and the related limitations in the other independent claims. At least two of the five references clearly do not qualify as prior art against this application,² and the other three, even if they qualify as prior art, which is not admitted, do not appear to be relevant.

² One of the new references, WO 0039735 (PCT international patent application PCT/US99/31061) of Bloomberg LP, is a PCT counterpart to this application, and claims priority of this application. Another new reference, WO 0163527 (PCT international application PCT/US01/05652) of Bonanza Com, was published on 30 August 2001 and claims priority of a US application filed on February 25, 2000, after the filing date of this application under examination.

Information Disclosure Statements

Since the new references identified by the Examiner are either not prior art or not relevant, we are not citing them in an Information Disclosure Statement. However, if the Examiner disagrees with Applicant's attorneys' assessment that these additional references are either not prior art or not relevant to the penalty box (or any other claim) limitation, he is requested to cite and apply the references in an office action and indicate with particularity what he believes to be their relevance. Although this may have the effect of provoking another office action which we sought to avoid, it seems to be the prudent way to proceed under the circumstances.

Receipt of the copy of the Information Disclosure Statement by Applicant list filed on 18 July 2000 and initialed by the Examiner is acknowledged. However, the Office has not provided Applicants attorneys with an initialed copy of the Information Disclosure Citation List filed 17 August 2001. Copies of the original Supplemental IDS (bearing a signed certificate of mailing), with which the Citation List was filed, and the Citation List are enclosed for the convenience of the Examiner.

CONCLUSION

Claims 1-26 are allowable over the prior art of record and that identified in the 20 September 2002 fax for the reasons discussed above.

Reconsideration and allowance of the application with claims 1-26 are requested.

Respectfully submitted,

 26,543

Dated: 29 November 2002

Matthew J. Marquardt
Reg. No. 40,997
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
(212) 895-2000
(212) 895-2900 FAX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Brian A. WESTON et al.
Serial No. : 09/476,935
Filed : 30 December 1999
Title : SYSTEM AND METHOD FOR IMPLEMENTING FOREIGN
EXCHANGE CURRENCY FORWARDS
Examiner : KYLE, Charles R. Group Art Unit: 3624

Commissioner for Patents
Washington, D.C. 20231

RECEIVED
DEC 09 2002
GROUP 3600

**ATTACHMENT TO RESPONSE TO 3 JULY 2002 OFFICE ACTION
REWRITTEN CLAIMS PURSUANT TO 37 CFR 1.121(c)
SHOWING CLAIMS 2-7, 10, 12-17 AND 21-26 IN MARKED-UP FORM**

2. (Amended) The system of claim 1, wherein the pre-set trading configurations correspond to filter settings for at least one filter criterion [criteria]; and wherein a first remote server, connected to a first workstation associated with a first trader having associated first filter settings, blocks from view by the first trader any currency trades from other traders not meeting the at least one filter criterion [criteria] corresponding to the first filter settings.

3. (Amended) The system of claim 2, wherein the at least one filter criterion [criteria] includes credit rating restrictions.

4. (Amended) The system of claim 2, wherein the at least one filter criterion [criteria] includes geographic restrictions.

5. (Amended) The system of claim 2, wherein the at least one filter criterion [criteria] includes institution-based restrictions.

6. (Amended) The system of claim 2, wherein the at least one filter criterion [criteria] includes trade amount restrictions.

7. (Amended) The system of claim 2, wherein the at least one filter criterion [criteria] including temporary restrictions is [are] used by the remote server to block the display of trades from the specified trader from view by the first trader.

10. (Amended) A system for conducting electronic trading of foreign exchange forwards, the system comprising:

- a central server for tracking currency trades;

- a plurality of trading workstations organized in a plurality of groups for conducting electronic data-based trading, with a portion of the trading workstations associated with respective telephones for conducting voice-based trading;

- a plurality of remote servers, each respective remote server being associated with a respective group of trading workstations and interfacing the respective group of trading workstations to the central server, wherein the remote servers mediate the currency trades between traders using the workstations by consulting pre-set trading configurations associated with each trader corresponding to filter settings for at least one filter criterion [criteria], which includes temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state relative to the first trader; and

- wherein a first remote server, connected to a first workstation associated with a first trader having associated first filter settings, blocks from view by the first trader any currency trades from other traders, including the specified trader in the penalty box

state, not meeting the at least one filter criterion [criteria] corresponding to the first filter settings.

12. (Amended) The method of claim 11, wherein the pre-set trading configurations correspond to filter settings for at least one filter criterion [criteria]; and wherein the step of mediating includes the steps of:

evaluating trades to and from a first workstation utilizing the first filter settings at a first remote server connected to the first workstation associated with a first trader having associated first filter settings; and

blocking from view by the first trader any currency trades from other traders not meeting the at least one filter criterion [criteria] corresponding to the first filter settings.

13. (Amended) The method of claim 12, wherein the at least one filter criterion [criteria] includes credit rating restrictions.

14. (Amended) The method of claim 12, wherein the at least one filter criterion [criteria] includes geographic restrictions.

15. (Amended) The method of claim 12, wherein the at least one filter criterion [criteria] includes institution-based restrictions.

16. (Amended) The method of claim 12, wherein the at least one filter criterion [criteria] includes trade amount restrictions.

17. (Amended) The method of claim 12, wherein the at least one filter criterion [criteria] includes temporary restrictions on the specified trader specified by the first trader for implementing the penalty box state of the specified trader.

21. (Amended) A system for conducting electronic trading of foreign exchange forwards, the system comprising:

- a central server for tracking currency trades;
- a plurality of trading workstations; and
- at least one remote server interfacing the trading workstations to the central server, wherein the at least one remote server mediates the currency trades between traders using the workstations by consulting filter settings for at least one filter criterion [criteria] associated with each trader; and

wherein a first remote server, connected to a first workstation associated with a first trader having associated first filter settings, blocks from view by the first trader any currency trades from other traders not meeting the at least one filter criterion [criteria] corresponding to the first filter settings, wherein the pre-set trading configurations include temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state.

22. (Amended) The system of claim 21, wherein the at least one filter criterion [criteria] includes credit rating restrictions.

23. (Amended) The system of claim 21, wherein the at least one filter criterion [criteria] includes credit geographic restrictions.

24. (Amended) A system for conducting electronic trading of foreign exchange forwards, the system comprising:

a central server for tracking currency trades;

a plurality of trading workstations; and

at least one remote server interfacing the trading workstations to the central server, wherein the at least one remote server mediates the currency trades between traders using the workstations by consulting at least one filter criterion [criteria] which

includes temporary restrictions on a specified trader specified by a first trader to put the specified trader into a penalty box state.

25. (Amended) A system for conducting electronic trading of foreign exchange forwards, the system comprising:

a central server for tracking currency trades;

a plurality of trading workstations; and

at least one remote server interfacing the trading workstations to the central server, wherein the at least one remote server mediates the currency trades between traders using the workstations using a database listing a set of traders, stored in a memory of the remote server, with which a first trader is willing to trade, and wherein the remote server uses pre-set trading configurations [include] including temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state; and

wherein the remote server, responsive to a selection by the first trader of a subset of the set of traders, conveys a request-for-quote transmission from the first trader to the selected subset of traders.

26. (Amended) A system for conducting electronic trading of foreign exchange forwards, the system comprising:

a central server for tracking currency trades;

a plurality of trading workstations; and

at least one remote server interfacing the trading workstations to

the central server, wherein the at least one remote server mediates the currency trades

between traders using the workstations using pre-set trading configurations [include]

including temporary restrictions on a specified trader set by a first trader to put the specified trader into a penalty box state;

wherein at least one trading workstation is associated with a telephone for providing voice communications between a trader associated therewith and other entities having telephone capabilities; and

wherein the trading workstation provides data communications between the trader associated therewith and other entities having data communication capabilities, thereby providing traders on the system with both voice-based and data-based trading functionality.